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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,143	09/25/2001	James Hugh McLaughlin	C&E, JHM-1	1702

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/22/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/964,143

Applicant(s)

MCLAUGHLIN, JAMES HUGH

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 35 and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 10.

2. Applicant's election with traverse of invention group I, claim 1-34 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the claimed composition may not be used for other purpose, such as washing dishes as exemplified by the examiner. This is not found persuasive because the alleged film forming property herein is particularly on human skin, due to the employment of surfactant (page 4, the last paragraph in the specification). There is no indication that the composition would form a film on ceramic materials, and one of ordinary skill in the art would have not expected the composition would form a film on dishes. Note inventions are in the same class and subclass is not a sufficient reasons to over come the restriction requirements. Search of invention group II, is not required for the search of invention group I.

The requirement is still deemed proper and is therefore made FINAL.

Applicants' traverse regarding the species election is persuasive. Particularly, all the materials herein employed are well-known cosmetic materials and they are not patentably distinct from each other. Therefore, the species election requirement is herein withdrawn.

Claim Rejections 35 U.S.C. 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "substantially" in claims 38 and 39 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The claims are indefinite as to the amount of water in the composition.

Claim Rejections 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8-20, 23-27, and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner.

8. Kellner teaches water and oil emulsion solid cosmetic compositions. The composition comprising up to 30% of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that addition emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30% (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26). Kellner further teaches that up to 20 % of primary gelling agent may used, wherein the preferred primary gelling agent are salt of fatty acid, particularly, calcium stearate (see col. 2, lines 24-65). Surfactants up to 20%

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are desirable in the composition. Surfactants, including cationic, anionic nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprising up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, etc. (see col. 19, lines 37-61). The water in the composition may range from 5% to 95% (see particularly, the claims).

9. Kellner does not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as corn starch, calcium stearate.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition with the particular percentages of each and every components herein since the percentage range herein defined are either encompassed by, or overlapped with the range disclosed by Kellner. Note it is well settled that in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Also see MPEP 2144.05. The employment of the particular ingredients such as corn starch or calcium stearate is obvious since they are known to be useful in the composition. The employment of such components in the composition is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

10. Claims 7, 21, 22, 28 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner for reasons discussed above, and in further view of Barker (US 5,360,824, IDS,

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claim 21, and 22)), Street (US 6,017,351, of record, claim 28). McAtee et al. ((US 6,153,208, claim 7) and Touzan et al. (U.S. 6,033,647, claim 38, 39).

11. Note Kellner does not teach expressly the employment of the particular oil, particulates, or surfactant herein.

12. However, Barker teaches sodium chloride particulate are known to be useful in cleansing composition (see claim 5). Street teaches that pumice is also not to be useful as skin compatible particulate in topical application (co. 7, lines 1-12), McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cleansing composition. (col. 20, lines 1-13). Touzan discloses that macadamia oil is similarly useful as other natural oil in cosmetic composition.

13. Applicants' amendments and remarks submitted October 1, 2002 and March 31, 2003 have been fully considered, but are moot in view of the new ground of rejections.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ such well-known ingredients in the cosmetic composition of Kellner et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

Shengjun Wang

August 21, 2003

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